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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/706,614 | 11/04/2000 | Daniel H. Illowsky | A-69997/RMA | 8522 |
| 7590 | 09/27/2004 | | EXAMINER | |
| FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP Suite 3400, Four Embarcadero Center San Francisco, CA 94111 | | | DUONG, FRANK | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2666 | |

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/706,614 | ILLOWSKY, DANIEL H. | |
| | Examiner Frank Duong | Art Unit 2666 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 November 2000.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) 1-29 is/are allowed.
 6) Claim(s) 30 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>01/28/02&02/26/01</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is a response to the communication dated 11/04/00. Claims 1-30 are pending in the application.

Information Disclosure Statement

2. The information disclosure statements filed 01/28/02 and 02/26/01 comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. They have been considered and placed in the application file.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 30 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/706,613. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following rationales.

Claim 30 of the instant application calls for:

A method for building an information stream for self-directed loading and playback in an information appliance', said method comprising steps of:
constructing a single physical or virtual file as a concatenation of a plurality of sub-files, which contain sets of logical tiles; and
constructing each sub-file to include at least one procedural thread having at least one executable instruction and optionally including parameters associated with said instruction.

Claim 1 of the copending application 09/706,613 calls for:

A method for streaming electronic content from a sender to a receiver over a communication link, said method comprising the steps of:
forming a single virtual story file comprising substantially the complete electronic content of comprising:
a set of logical tiles, each logical file including a header indicating that the first logical file procedural/data content offset is 0 and that the last procedural/data element offset is the size of the logical file procedural/data content less one atomic element;
automatically and intelligently reforming the single virtual story file into a plurality of sequentially arrayed subfiles, each subfile including: (i) a header identifying a first subfile offset from a reference location in the single virtual file and containing a substantially complete story for a predetermined playback period or playback functionality; (ii) a currently executable portion with each said subfile that executes

when said subfile is opened after receipt; and (iii) a control portion that controls loading and execution of other subfiles;

communicating said single virtual tile over said communication link in a data stream at a data rate commensurate with available bandwidth and characteristics of said communication link, said physical tile being received by said receiver as sequential portions of said single virtual file in the form of individual subfiles; and

the opening of a later received subfile being controlled by a previously received subfile such that each said currently executable portion of each of said subfiles is executed only upon the direction of an earlier executing subfile.

A skilled artisan would have recognized the claimed invention of claim 30 of the instant application encompasses the claimed invention of claim 1 of the copending application 09/706,613. In other words, the claimed invention of claim 1 of the copending application teaches essentially the same steps as claim 30 of the current application. Even though claim 30 is broadened by omitting certain limitations (“*communicating ... subfiles*”), it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 136 USPQ 184(CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

In addition, the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant

application are claiming common subject matter. Thus, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 30 is rejected under 35 U.S.C. 102(e) as being anticipated by Balabanovic (USP 6,480,191).

Regarding **claim 30**, in accordance with Balabanovic reference entirely, Balabanovic discloses a method (Fig. 3) for building an information stream (multimedia chronicles) for self-directed loading and playback in an information appliance (col. 1, lines 8-10), said method comprising steps of:

constructing a single physical or virtual file (300) as a concatenation of a plurality of sub-files (320 and 340), which contain sets of logical files (*Fig. 3A, col. 8, lines 33-35 and thereafter*) ; and

constructing each sub-file (320 or 340) to include at least one procedural thread (321 or 342) having at least one executable instruction (references) and optionally including parameters associated with said instruction (*Fig. 3A and col. 8, line 35 to col. 9, line 11*).

Allowable Subject Matter

5. Claims 1-29 are allowed.
6. The following is a statement of reasons for the indication of allowable subject matter:
The prior art of record, considered individually or in combination, fails to fairly show or suggest the claim invention of claims 1-29 comprising, among other limitations, the novel, unobvious limitation of "*setting said first thread input memory buffer to be associated with the logical file in the input stream having content ID zero (CID=0) and current file number zero (CFN=0) so that at story playback startup the device loads from the first content portion (CID=0) of CFN=0=content file number*", structurally and functionally interconnected with other limitations in a manner as recited in the claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gifford et al (USP 6,549,612).

Boaz et al (USP 5,333,266).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is (571) 272-3164. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frank Duong
Examiner
Art Unit 2666

September 21, 2004